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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER T. AYLWARD,
NARASIMHARAO DONTULA, TERRY A. HEATH,
RICHARD D. BOMBA, and JOHN E. BENSON

Appeal 2008-3415
Application 10/780,263¹
Technology Center 1700

Decided: November 19, 2008

Before BRADLEY R. GARRIS, TERRY J. OWENS, and
MARK NAGUMO, *Administrative Patent Judges*.

NAGUMO, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application 10/780,263, *Foam Core Imaging Element with Gradient Density Core*, filed 17 February 2004. The specification is referred to as the “263 Specification,” and is cited as “Spec.” The real party in interest is listed as Eastman Kodak Company (Appeal Brief Pursuant to 37 C.F.R. § 41.37 and 35 U.S.C. § 134 (“Br.”), 1.)

Introduction

Peter T. Aylward, Narasimharao Dontula, Terry A. Heath, Richard D. Bomba, and John E. Benson (“Aylward”) timely appeal under 35 U.S.C. § 134(a) from the final rejection² of claims 1-11, 14-20, and 22-49.³ More specifically, the Examiner has rejected claim 26 as indefinite under 35 U.S.C. § 112(2). The Examiner has also rejected all appealed claims as obvious under 35 U.S.C. § 103(a). We have jurisdiction under 35 U.S.C. § 6(a). We AFFIRM the rejection of claim 26 as indefinite and we REVERSE the remaining rejections.

The subject matter on appeal relates to a substrate bearing an imaging layer. Claims 1 and 26, which illustrate the issues necessary to resolve this appeal, are reproduced below.

Claim 1 (Claims App., Br. 65; paragraphing and indentation added):

An article comprising

 a base wherein said base comprises

 a closed cell foam core sheet, wherein said closed
 cell foam core sheet comprises

 at least one closed cell foam layer, wherein
 said at least one closed cell foam layer
 comprises a polymer that has been expanded
 through the use of a blowing agent, and
 wherein said closed cell foam layer has a
 density wherein said density comprises a
 gradient,

and wherein said article further comprises

 at least one imaging layer applied thereto.

² Office Action mailed 28 December 2006 (“FR”).

³ The only other pending claims (50-91) have been withdrawn from consideration and are not before us.

Claim 26 (Claims App., Br. 68):

The article of Claim 1 wherein said imaging layer comprises a thermal imaging layer sold under the trademark AUTOCHROME.

The Examiner has maintained the following rejections:

- A. Claim 26 stands rejected under 35 U.S.C. § 112(2) as indefinite in the term “AUTOCHROME,” which is said to be a trademark.
- B. Claims 1-49 stand rejected under obviousness-type double-patenting over claims 1-26 of Dontula 656⁴ and Reeves.⁵
- C. Claims 1-3 and 7-11 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and MacAulay.⁶
- D. Claims 1-11 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and Lynn.⁷
- E. Claims 1-3, 7-11, 15, and 18 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and Gluck.⁸
- F. Claims 1-11, 14-20, and 29 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and Gehlsen.⁹
- G. Claims 1-11, 19-20, 22-25, 28-39, and 41-48 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and Dontula 976.¹⁰

⁴ Narasimharao Dontula et al., U.S. Patent 6,537,656 B1 (2003).

⁵ Charlie Reeves and Stephen Crane, U.S. Patent 5,916,672 (1999).

⁶ John J. MacCaulay, U.S. Patent 6,872,673 B2 (2005).

⁷ Gregory W. Lynn et al., U.S. Patent 6,093,481 (2000).

⁸ David G. Gluck and Wayne E. Laughlin, U.S. Patent 4,764,420 (1988).

⁹ Mark D. Gehlsen and Bradley S. Momchilovich, U.S. Patent 6,103,152 (2000).

¹⁰ Narasimharao Dontula et al., U.S. Patent 6,447,976 B1 (2002).

- H. Claim 26 stands rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves, Dontula 976, and Yamaguchi.¹¹
- I. Claim 27 stands rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves, Dontula 976, and Tsuda.¹²
- J. Claim 40 stands rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves, Dontula 976, and O'Neill.¹³
- K. Claims 1-11, 19-20, 22-25, 28-39, and 41-49 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and Dontula 656.

Indefiniteness

The Examiner finds that the term AUTOCHROME is a Registered Trademark. The Examiner reasons that because trademarks identify the source of the goods, rather than the good themselves, that the goods covered by the mark AUTOCHROME are not adequately defined for use in a claim, as they would be if an appropriate generic description were used. The Examiner concludes that claim 26 is indefinite. (Ans. 3.)

Aylward objects that it has complied with provisions in the Manual for Patent Examining Procedure (“MPEP”) § 608.01(v) regarding the use of trademarks in applications and that the rejection should be withdrawn. (Br. 4-5.)

The dispositive issue in this rejection is, does the term AUTOCHROME as used in claim 26 adequately inform the concerned public of the bounds of the claimed subject matter?

¹¹ Yoshihiro Yamaguchi, U.S. Patent 6,876,461 B1 (2005).

¹² Masashi Tsuda, U.S. Patent 6,342,329 B1 (2002).

¹³ Michael A. O'Neill et al., U.S. Patent 6,627,018 B1 (2003).

Findings of Fact

1. Aylward submits that the term AUTOCHROME is a Registered Trademark for a thermal imaging system sold by Fuji Photo Film Co., Ltd. (“Fuji”) citing U.S. Patent 7,153,620, which is represented as so-characterizing the mark.)
2. A search of the USPTO Trademark Electronic Search System (TESS¹⁴) shows that registrations of terms containing the mark AUTOCHROME are dead.
3. According to TESS, the term AUTOCHROME (not assigned to Fuji) covered staining reagents for tissue specimens on microscope slides, while the terms assigned to Fuji, TA THERMO-AUTOCHROME and THERMO AUTOCHROME covered heat sensitive paper, printers, and printing processes.
4. MPEP 608.01(v) (8th Ed., Rev. 6 (September 2007)¹⁵) reads:
Names used in trade are permissible in patent applications if:
(A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or
(B) In this country, their meanings are well-known and satisfactorily defined in the literature.

¹⁴ Accessed 6 November 2008 at
<http://tess2.uspto.gov/bin/gate.exe?f=tess&state=jalq11.1.1>

¹⁵ The text is identical to that in MPEP 8th Ed., Rev. 2003, which was in force when the 263 Application was filed.

Principles of Law

We are not aware of any case in which the Federal Circuit or its antecedent courts have ruled on the indefiniteness *vel non* of claims that recite trademarks. The Board of Patent Appeals and Interferences recently released *Ex parte Casey*,¹⁶ designated as an “informative opinion,” that discusses prior decisions in patent appeals involving trademarks and concludes that the use of a trademark in an application or in a claim must be considered case-by-case.

The Federal Circuit has explained that:

35 U.S.C. § 112, ¶ 2 requires that the specification of a patent ‘conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.’ Because claims delineate the patentee's right to exclude, the patent statute requires that the scope of the claims be sufficiently definite to inform the public of the bounds of the protected invention, i.e., what subject matter is covered by the exclusive rights of the patent. Otherwise, competitors cannot avoid infringement, defeating the public notice function of patent claims.

Halliburton Energy Services, Inc. v. M-I LLC, 514 F.3d 1244, 1249 (Fed. Cir. 2008).

During prosecution of an application for patent, “the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description

¹⁶ *Ex parte Casey* (BPAI 2008) is available on-line at:
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd074317.pdf>

contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

A trademark is a mark by which the trademark owner may distinguish "the goods in connection with which the mark is used" from the goods of others. 15 U.S.C. § 1051(a)(1) and § 1052.

Analysis

At first glance, there appears to be no ambiguity as to what subject matter is covered by claim 26, namely, articles within the scope of claim 1 have a thermal imaging layer sold under the trademark AUTOCHROME. The problem is that a trademark has a formal legal meaning: it distinguishes the goods sold by the trademark owner under that mark from the goods of others. It is hornbook trademark law that a trademark does not identify the goods themselves. The trademark owner may properly mark any goods it sells that are within the scope of the goods identified in its trademark application as the "goods in connection with which the mark is used." Moreover, Aylward has not directed our attention to credible evidence of record that the term AUTOCHROME has become generic—i.e., that the ordinary worker in the art would consider it a common name for thermal printing layers. Therefore, on the present record, a person using or selling a similar article would have no practical way of determining whether they were infringing claim 26 short of determining whether any thermal imaging layer was being sold or was available in this country under the mark AUTOCHROME. The scope and impracticality of the inquiry demonstrate that claim 26 does not "particularly point out and distinctly claim" the subject matter Aylward regards as the invention.

Aylward's reliance on the MPEP is misplaced. The MPEP passage explains that names used in trade may be used in an application if they are either adequately defined or their meanings are well known in this country and satisfactorily defined in the literature. However, the MPEP passage does not endorse the use of names used in trade in the claims. Indeed, if the conditions for use of trademarks in the application are met, then generic descriptions of the marks are available for use in the claims, and there would be no need to use the trademarks in the claims. Claim 26, although it contains the generic language "thermal imaging system," limits the scope with the term AUTOCHROME. That term does not adequately inform the concerned public of the bounds of the claimed subject matter. We must take the claims as they are, not as an appellant would have them read.

We therefore AFFIRM the rejection of claim 26 for indefiniteness.

Rejections over Art

Aylward contends the Examiner erred by construing the claims as requiring at least one closed cell foam layer that has a density gradient. (Br. 7, 3d paragraph.)

The Examiner construes claim 1 as requiring at least one closed cell foam layer (Ans. 23, last paragraph; FR 22, ¶ 12), but denies that the claims require that the recited gradient exist within a single layer (Ans., paragraph bridging 23-24). In each of the rejections over art, including the obviousness-type double patenting rejection, the Examiner relies on Reeves as teaching a closed foam core sheet having a density gradient formed by multiple closed foam layers, as shown in Reeves Figure 3. (E.g., Ans. 4 (obviousness type double patenting) and at 5-6 (obviousness).) The

Examiner argues that, “while Reeves doesn’t state the density gradient decreas[es] from center to surface or the use of three foam layers, it would have been obvious to one having ordinary skill to modify the invention based on the teachings of Reeves above (col. 6, lines 14-50).” (*Id.* at 6, 2d paragraph.) The Examiner argues that such modification would have amounted to the routine optimization of a result effective variable. (*Id.*)

The dispositive issue in each of the rejections over art is, did the Examiner err in construing claim 1 as not requiring that the recited closed cell foam layer have a density gradient?

Analysis

Claim 1 covers an article that comprises a base that comprises a closed cell foam core sheet that comprises at least one closed cell foam layer. The at least one closed cell foam layer “has a density, wherein said density comprises a gradient.” The plain meaning of the claim is that there must be at least one closed cell foam layer that contains a density gradient. The Examiner’s reasoning to the contrary is wrong.

Moreover, the Examiner’s reliance on the alleged teachings of the 263 Specification is not clear. It appears that the Examiner argues that examples in the 263 Specification indicate that the term “layer” as used by Aylward encompasses plural layers. For example, the Examiner argues that there is no support in the 263 Specification for a single layer having a density gradient. (Ans. 24.) The Examiner then argues that the example in the 263 Specification at page 17, lines 12-17, teaches making two-layer gradients by extruding two different polymeric mixtures with different blowing (expansion) agents. (*Id.*) The Examiner appears to imply that a

“single layer,” as Aylward uses that term, can include what Reeves describes as a two-layer core. (*Id.*) But, if this is the case, it is not clear that there is any need to modify Reeves for density gradients. Moreover, the Examiner’s finding that the 263 Specification does not teach a way of making single closed cell layers from polymers with blowing agents having internal density gradients (Ans. 24) is directly contradicted by the description in the 263 Specification, at page 17, lines 24-30, immediately following the cited example, in which the density gradient is provided by quenching the extruded closed cell foam sheet against a cold surface. Thus, the Examiner has failed to establish an evidentiary basis in the supporting specification for the proposed claim construction.

Because all of the Examiner’s rejections rely on an incorrect construction of the claimed subject matter, all of the rejections based on art are REVERSED.

Order

We ORDER that the rejection of claim 26 under 35 U.S.C. § 112(2) is AFFIRMED;

FURTHER ORDER that the rejection of claims 1-49 under obviousness-type double-patenting over claims 1-26 of Dontula 656 and Reeves is REVERSED;

FURTHER ORDER that the rejection of claims 1-3 and 7-11 under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and MacAulay is REVERSED;

FURTHER ORDER that the rejection of claims 1-11 under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and Lynn is REVERSED;

FURTHER ORDER that the rejection of claims 1-3, 7-11, 15, and 18 under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and Gluck is REVERSED;

FURTHER ORDER that the rejection of claims 1-11, 14-20, and 29 under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and Gehlsen is REVERSED;

FURTHER ORDER that the rejection of claims 1-11, 19-20, 22-25, 28-39, and 41-48 under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and Dontula 976 is REVERSED;

FURTHER ORDER that the rejection of claim 26 under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves, Dontula 976, and Yamaguchi is REVERSED;

FURTHER ORDER that the rejection of claim 27 under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves, Dontula 976, and Tsuda is REVERSED;

FURTHER ORDER that the rejection of claim 40 under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves, Dontula 976, and O'Neill is REVERSED;

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FURTHER ORDER that the rejection of claims 1-11, 19-20, 22-25, 28-39, and 41-49 under 35 U.S.C. § 103(a) in view of the combined teachings of Reeves and Dontula 656 is REVERSED; and

FURTHER ORDER that no time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

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